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FINCHAM DOWNS, LLC
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RIDGEFIELD CT 06877

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AUG 30 2011
OFFICE OF PETITIONS

In re Patent No. 5,542,662 :
Issue Date: 08/06/1996 :
Application Number: 08/355,707 : DECISION ON PETITION
Filing Date: 12/14/1994 :
Attorney Docket Number: :
69200A756 :
:

This is a decision on the petition filed on June 22, 2011, under 37 CFR § 1.378(b) to accept the delayed payment of a maintenance fee for the above-identified patent.

The petition is dismissed.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of \$400.00 as set forth in 37 CFR 1.17(f). The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below, since, after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director.

The patent issued August 6, 1996. The first and second maintenance fees were timely paid. The third maintenance fee could have been paid from August 6, 2007, through February 6,

2008, or, with a surcharge during the period from February 7 through August 6, 2008. Accordingly, the patent expired at midnight August 6, 2008, for failure to timely submit the maintenance fee.

Petitioner asserts that registered patent practitioner Bonnie Drinkwater (hereinafter "Drinkwater"), via her law firm, the Drinkwater Law Offices (hereinafter "DLO") was responsible for payment of the third maintenance fee, and that the due dates for payment of the third maintenance fee were to have been entered into DLO's Microsoft Outlook calendaring system by DLO's then paralegal, Cindy Hill (hereinafter "Hill"), who was responsible for entering the maintenance fee due dates in the calendaring system. However, the due dates for payment of the third maintenance fee for the subject patent were not entered into the calendaring system, and the maintenance fee was not timely paid.

Petitioner also asserts that no notice of patent expiration was received because the USPTO mailed the notice of patent expiration to the prior counsel of record, Darby & Darby. Petitioners further assert, through the declaration of Bonnie Drinkwater, that it is believed that the USPTO send the notice of renewal for the subject patent to DLO's old address.

A petition to accept the delayed maintenance fee under 35 U.S.C. § 41(c) and 37 CFR 1.378(b) must be accompanied by (1) an adequate, verified showing that the delay was unavoidable, since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent, (2) payment of the appropriate maintenance fee, unless previously submitted, and (3) payment of the surcharge set forth in 37 CFR 1.20(i)(1).

This petition lacks requirement (1).

A late maintenance fee is considered under the same standard as that for reviving an abandoned application under 35 U.S.C. § 133 because 35 U.S.C. § 41(c)(1) uses identical language (i.e. "unavoidable delay").¹ Decisions reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable.² In this regard:

¹ Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995) (quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1989)).

² Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.³

The Director may accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Director to have been "unavoidable".⁴ A patent owner's failure to pay a maintenance fee may be considered to have been "unavoidable" if the patent owner "exercised the due care of a reasonably prudent person."⁵ This determination is to be made on a "case-by-case basis, taking all the facts and circumstances into account."⁶ Unavoidable delay under 35 U.S.C. § 41(b) is measured by the same standard as that for reviving an abandoned application under 35 U.S.C. § 133.⁷ Under 35 U.S.C. § 133, the Director may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to have been "unavoidable". Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable.⁸ However,

greater care or diligence than is generally used by prudent and careful men in relation to their most important business").

³ In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

⁴ 35 U.S.C. § 41(c) (1).

⁵ Ray v. Lehman, 55 F.3d 606, 608-09 (Fed.Cir.), cert. denied, -- U.S. ---, 116 S.Ct. 304, L.Ed.2d 209 (1995).

⁶ Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

⁷ In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (PTO Comm'r 1988).

⁸ Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or

a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay.⁹ In view of In re Patent No. 4,409,763, this same standard will be applied to determine whether "unavoidable" delay within the meaning of 37 CFR 1.378(b) occurred.

This petition does not satisfy the requirement of 37 CFR 1.378(b)(3). The statements presented in the petition fail to satisfy the showing required to establish unavoidable delay within the meaning of 37 CFR 1.378(b).

As 35 U.S.C. § 41(c) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 U.S.C. § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees.¹⁰ That is, an adequate showing that the delay was "unavoidable" within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent.¹¹

With regard to period (1), above, a delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown that:

- (1) the error was the cause of the delay at issue;
- (2) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance;
- (3) and the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.¹²

greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

⁹ Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

¹⁰ Ray, 55 F.3d at 609, 34 USPQ2d at 1788.

¹¹ Id.

¹² See MPEP 711.03(c) (III) (C) (2).

An adequate showing requires:

(A) Statements by all persons with direct knowledge of the circumstances surrounding the delay, setting forth the facts as they know them.

(B) Petitioner must supply a thorough explanation of the docketing and call-up system in use and must identify the type of records kept and the person responsible for the maintenance of the system. This showing must include copies of mail ledgers, docket sheets, filewrappers and such other records as may exist which would substantiate an error in docketing, and include an indication as to why the system failed to provide adequate notice that a reply was due.

(C) Petitioner must supply information regarding the training provided to the personnel responsible for the docketing error, degree of supervision of their work, examples of other work functions carried out, and checks on the described work which were used to assure proper execution of assigned tasks.

The present petition lacks the showing required by (1), (2), and (3) above.

At the outset, it is noted that petitioners have not provided a statement from Hill, the person who allegedly made the error in failing to docket the due dates for the third maintenance fee for the subject patent. Petitioner must obtain a statement or declaration of facts from Hill stating the facts as she knows them surrounding the entry of the due dates for the third maintenance fee for the subject patent into the docketing system utilized by DLO.

Further, petitioner must supply information regarding the training provided to the personnel responsible for the docketing error, degree of supervision of their work, examples of other work functions carried out, and checks on the described work which were used to assure proper execution of assigned tasks.

In this regard, while the petition and the declaration of Drinkwater both state that Drinkwater supervised Hill, petitioner has not supplied detailed information regarding the supervision of and checks on the described work which were used to assure proper execution of assigned tasks.

More to this point, it is noted that Drinkwater's declaration states, in pertinent part:

11. In about February 2005, Drinkwater Law Offices filed with the USPTO an assignment for the '662 patent on behalf of Tachikarao. The assignment was recorded and included the address of the Drinkwater Law Offices at that time, which was 6490 S. McCarran Blvd, Suite B-15, Reno, NV 89509. Attached hereto is a true and correct copy of the Notice of Recordation of the Assignment of Patent (EXHIBIT B).

12. In September 2005, the Drinkwater Law Offices relocated to its current location, 5421 Kietzke Lane, Suite 100, Reno, NV 89511. As part of the move, Drinkwater Law Offices set up procedures designed to ensure that all files it had with the USPTO were updated with the new address information.

13, in September 2005, I verbally instructed Ms. Hill to file change of address forms with the USPTO to update Drinkwater Law Offices' new address for each file and to use the records saved in the Outlook calendaring and excel spreadsheet system to confirm that each file had been updated. Ms. Hill informed me that she had updated all of the files using the docketing systems. However, the assignment of the '662 patent does not appear to have made it into the docketing system. As a result, it does not appear that Ms. Hill filed a change of address form for the '662 patent. That is the only file Drinkwater Law Offices had with the USPTO that appears to not have been updated with Drinkwater Law Offices' new address.

14. Drinkwater Law Offices never received a notice of renewal for the '662 patent. I suspect this is because the USPTO had the old Drinkwater Law Offices' address, and by the time the notice was sent, no forwarding service was operating.

Petitioner's contention that they did not receive any notification from the USPTO that the maintenance fee was due is not well taken. A patentee's lack of knowledge of the need to pay the maintenance fee and the failure to receive the Maintenance

Fee Reminder do not constitute unavoidable delay.¹³ Under the statute and regulations, the Office has no duty to notify patentees of the requirement to pay maintenance fees or to notify patentees when the maintenance fees are due. The Office mailing of Maintenance Fee Reminders is carried out strictly as a courtesy. Accordingly, it is solely the responsibility of the patentee to assure that the maintenance fee is timely paid to prevent expiration of the patent. The lack of knowledge of the requirement to pay a maintenance fee and/or the failure to receive the Maintenance Fee Reminder (or a Notice of Patent Expiration) will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office.¹⁴

Rather than unavoidable delay, the showing of record is that petitioner lacked a reliable system for tracking and paying maintenance fees. The showing of record suggests that petitioner relied upon the receipt of some type of correspondence from the USPTO (i.e., an assignment recordation notice, a maintenance fee reminder, or a notice of patent expiration) in order to docket and track the maintenance fee payments. It is not understood why petitioner would rely upon the receipt of correspondence from the USPTO in order to docket the payment of the third maintenance fee. As the Office has no duty to notify patentee of the requirement to pay maintenance fees or to notify patentee when the maintenance fees are due, a showing of unavoidable delay requires a showing of a system to docket and pay the maintenance fees which does not rely upon receipt of a Maintenance Fee Reminder or other notice regarding payment of the maintenance fees received from the USPTO. Rather than an error on the part of a trusted and reliable employee, the showing of record suggests that the error occurred because petitioners awaited receipt of correspondence from the USPTO in order to docket and track the maintenance fee payments, and that when the expected correspondence did not arrive, petitioners lacked a process to docket the maintenance fee payment in the absence of the correspondence. Rather than unavoidable delay, the showing of record of a defect in the business routine in that petitioner relied upon the receipt of correspondence from the USPTO in order to docket and track the third maintenance fee for the subject patent.

¹³ See Patent No. 4,409,763, *supra*; see also "Final Rules for Patent Maintenance Fees" 49 Fed. Reg. 34716, 34722-34723 (August 31, 1984), reprinted in 1046 Off. Gaz. Pat. Office 28, 34 (September 25, 1984).

¹⁴ *Rydeen v. Quigg*, 748 F. supp. at 900.

Drinkwater's declaration states that "[t]here is no reason that the DLO law firm can find for the fact that the third maintenance fee for the '662 patent was not paid." However, a petition to reinstate a patent which has where payment of the maintenance fee was unavoidably delayed cannot be granted if the petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay.¹⁵ In this case, petitioner's inability to find a reason that the payment of the maintenance fee was delayed does not equate to an affirmative showing of unavoidable delay.

Lastly, it is noted that the petition states:

Further, an outside party, Leason Ellis, after the dissolution of Darby and Darby, inexplicably made itself the fee address of record for the '662 patent in manner that could not have been detected by Tachikara or DLO law firm. Neither Darby and Darby nor Leason Ellis informed Tachikara or DLO law firm of the expiration of the '662 patent, and it is not clear that they knew.

This argument, too, is unpersuasive, for petitioner's argument is again that it relied upon receiving maintenance fee reminders or other correspondence from the USPTO in order to docket the maintenance fees. As stated above, the failure to receive maintenance fee reminders from the Office does not constitute unavoidable delay.¹⁶ As such, no matter where the Office was sending the reminders, or if the Office sent no reminders at all, the failure of petitioners to receive them would not result in a showing of unavoidable delay. Still further, whether or not another party was aware that the patent had expired and failed inform petitioners is irrelevant, as the showing of record is that petitioners, not another party, were responsible for tracking and paying the maintenance fee, but failed so to do.

In summary, the showing of record is inadequate to establish unavoidable delay. Rather, the showing of record is that petitioner failed to take adequate precautions to ensure that maintenance fees were timely paid in the event of a failure to receive mailed correspondence from the USPTO. Petitioner's apparent reliance on the receipt of correspondence from the USPTO in order to docket and track the maintenance fee constitutes a lack of diligence, not unavoidable delay.¹⁷ As petitioner has not

¹⁵ Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

¹⁶ See note 14, supra.

¹⁷ See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

shown that it exercised the standard of care observed by a reasonable person in the conduct of his or her most important business, the petition will be dismissed.¹⁸

Petitioner should note that if this petition is not renewed, or if renewed and not granted, then the maintenance fee and post-expiration surcharge are refundable. The \$400.00 petition fee for seeking reconsideration is not refundable. Any request for refund should be in writing to the address noted below.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 Attn: Office of Petitions

By hand: Customer Service Window
 Mail Stop Petition
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Telephone inquiries should be directed to the undersigned at 571-272-3231.



Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

¹⁸ See note 3, supra.

STATEMENT UNDER PARAGRAPH 8

Brief Summary

Despite (1) reliance on an industry-standard calendaring system; (2) a well-established and reliable procedure for processing docketing action items; and (3) oversight by a competent and reliable intellectual property attorney who had paid hundreds of fee payments, the third maintenance fee for U.S. Patent No. 5,542,662 ("the '662 patent") was not paid. Tachikara USA, Inc. ("Tachikara") and the Drinkwater Law Offices ("DLO") law firm exercised the care and diligence generally used and observed by prudent and careful men in relation to their most important business and relied on worthy and reliable employees. Further, the fee address for the '662 patent was incorrect at the time the third maintenance fee was due, as the firm then of record, Darby and Darby, had moved in 2007, and Darby and Darby apparently failed to update the USPTO when it moved and when it ultimately dissolved in 2010. A finding of unavoidable delay is necessary in order to avoid an inequitable loss of patent rights.

The detailed facts as set forth below are supported by Declarations of persons personally acquainted with them. Briefly, the DLO law firm was responsible for paying the third maintenance fee on the '662 patent as part of its consolidated handling of all intellectual property matters for Tachikara. From its inception, the DLO law firm has used the well-known Microsoft Outlook calendaring system (and a parallel Microsoft Excel spreadsheet system) for tracking fees due for maintaining intellectual property assets before the United States Patent and Trademark Office ("USPTO"). The DLO law firm also had a capable, trained employee that was responsible for creating and overseeing the docket and files. The employee followed established procedures for ensuring that items were properly entered in the docketing system, and that reminders for filing fees were distributed to the responsible attorney. The responsible attorney also ensured that action items and due dates were met.

In this case, the responsibility for paying the third maintenance fee for the '662 patent was, ultimately, that of Ms. Bonnie Drinkwater, the principal attorney for the '662 patent and other Tachikara intellectual property matters. The due date for the '662 patent's third maintenance fee payment was never entered into the calendaring system by Ms. Drinkwater's then paralegal, Ms. Cindy Hill. Ms. Hill had worked at the DLO law

firm since 2002 and was a competent and reliable employee. DLO filed with the USPTO an assignment for the '662 patent on behalf of Tachikara. The assignment was recorded and included the address of the DLO law firm at that time, which was 6490 S. McCarran Blvd., Suite B-15, Reno, NV 89509.

A current investigation of the records of the USPTO shows that the USPTO on September 1, 2008, sent a notice of patent expiration for the '662 patent to Darby and Darby at the address of 805 Third Avenue, New York, NY 10022 (EXHIBIT X). Darby and Darby, however, had moved to 7 World Trade Center, 250 Greenwich St., New York, NY 10007-0042 on May 28, 2007 (EXHIBIT Y). Darby and Darby subsequently dissolved as a law firm in 2010, within the twenty-four months from expiration during which a petition to accept delayed payment for unintentional could have been filed (EXHIBIT Z). Leason Ellis LLP, with whom Tachikara was not engaged for legal services, subsequently and inexplicably filed a change of fee address for the '662 patent with the USPTO on April 22, 2010 (still within the twenty-four month period), but apparently failed to recognize that the '662 patent was expired at the time, and failed to contact either DLO (the correspondence address of record) or Tachikara. Neither Tachikara nor DLO received any correspondence from either the USPTO, or Darby and Darby, or Leason Ellis, with respect to the expiration of '662 patent. Therefore, there was no reason for Ms. Drinkwater or for any other reasonably prudent person under these circumstances, to examine the '662 patent file itself to confirm payment of the third maintenance fee or otherwise question the status of that patent.

The first time Tachikara and the DLO law firm became aware of the missed payment was on March 24, 2011, when Ms. Drinkwater discovered the expiration of the '662 patent. Immediately, Tachikara sought counsel to investigate the non-payment.

Thus, despite (1) reliance upon a reliable computer calendaring system, (2) a well-established and reliable procedure for processing docketed action items, and (3) oversight by a competent and reliable intellectual property attorney who had paid hundreds of fee payments, the third maintenance fee for the '662 patent was not paid. Further, the failures of Darby and Darby and Leason Ellis to recognize the error in the fee address make the failure to provide the maintenance fee payment unavoidable under the appropriate USPTO standards. Ms. Drinkwater had no reason to doubt that the '662 patent had been

properly docketed in the DLO law firm's calendaring system and the USPTO did not generate reports or notices to DLO indicating otherwise.

Once Tachikara became aware of this issue, counsel was immediately consulted. After the matter was investigated and evidence gathered, this Petition was promptly prepared and submitted.

It is respectfully submitted that the present petition should be granted.

Applicable Legal Standards

Pursuant to 35 U.S.C. 41(c)(1):

The Director may accept the payment of any maintenance fee required by subsection (b) of this section ... after the six-month grace period if the delay is shown to the satisfaction of the Director to have been unavoidable.

Decisions on reviving abandoned applications, or reinstating patents, on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Com'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552 (D.D.C. 1963), *aff'd*, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

Given the facts above and the definition of "unavoidable", the Petitioner respectfully submits that it has made a clear showing that the failure to pay the second maintenance fee for the '216 patent was unavoidable and therefore has met its burden. Initially, the DLO law firm has exercised great care and diligence consistent with how

"prudent and careful men [act] in relation to their most important business". The DLO law firm has an established and well run docketing system and has taken the due care necessary to insure that all maintenance fees were paid. The DLO law firm handled the payment of the second maintenance fee for the '216 patent in the same fashion as it does for other maintenance fees. Further, in accordance with its exercise of care, the DLO law firm relied upon a worthy and reliable employee who had not previously given any cause not to be trusted or to not perform her requisite duties in a proper manner. See, California Medical Product, Inc. v. Tecnol Medical Products, Inc., 921 F. Supp. 1219 (D. Del. 1995) (incorrect payment date docketed); Laerdal Medical Corp. v. Ambu., Inc., 87 F.Supp. 255 (D. Md. 1995) (secretary to patent attorney docketed an incorrect maintenance fee due date).

Remarks

There is no reason that the DLO law firm can find for the fact that the third maintenance fee for the '662 reissue patent was not paid. The matter was discussed between Ms. Drinkwater and Ms. Hill and Ms. Hill assured her that the DLO's files had been updated as requested by Ms. Drinkwater. Why Ms. Hill did not enter the third maintenance fee for the '662 patent is unknown. In any event, the third maintenance fee was not paid despite Tachikara's taking all reasonable and prudent steps to engage the DLO law firm to care for all of its intellectual property matters, including with the respect to the '662 patent that the DLO law firm helped Tachikara acquire, the DLO law taking all reasonable and prudent steps to make sure docketed items were recorded, noticed and taken care of, and having competent and trained staff to administer them.

Further, an outside party, Leason Ellis, after the dissolution of Darby and Darby, inexplicably made itself the fee address of record for the '662 patent in a manner that could not have been detected by Tachikara or DLO law firm. Neither Darby and Darby nor Leason Ellis informed Tachikara or DLO law firm of the expiration of the '662 patent, and it is not clear that they knew.

The failure to pay the third maintenance fee was thus unavoidable and the '662 patent should be reinstated. There was no reasonable way that the Petitioner, the DLO law firm, or any reasonable attentive and prudent person would have realized that the

third maintenance fee for the '662 patent had not been paid. Only through an unavoidable set of circumstances, beyond the Petitioner's control, was that third maintenance fee not paid. Further, only through an unavoidable set of circumstances, involving the dissolution and inexplicable involvement of outside law firms beyond the Petitioner's control, was the Petition unable to submit a petition to reinstate for unintentional delay within the required twenty-four month period for filing such. No one affiliated with the '662 patent could have learned of its expiration or had reason to question its status, until March 24, 2011.

Conclusion

The present situation is one where the expiration of the '662 patent was truly unavoidable. Thus, the Petitioner respectfully submits that its Petition to Accept the Late Maintenance Fee must be granted.



UNITED STATES PATENT AND TRADEMARK OFFICE

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09/01/08

NOTICE OF PATENT EXPIRATION

According to the records of the U.S. Patent and Trademark Office (USPTO), payment of the maintenance fee for the patent(s) listed below has not been received timely prior to the end of the six-month grace period in accordance with 37 CFR 1.362(e). THE PATENT(S) LISTED BELOW HAS THEREFORE EXPIRED AS OF THE END OF THE GRACE PERIOD. 35 U.S.C. 41(b). Notice of the expiration will be published in the USPTO Official Gazette.

Expired patents may be reinstated in accordance with 37 CFR 1.378 if upon petition, the maintenance fee and the surcharge set forth in 37 CFR 1.20(i) are paid, AND the delay in payment of the maintenance fee is shown to the satisfaction of the Director to have been unavoidable or unintentional. 35 U.S.C. 41(c)(1).

If the Director accepts payment of the maintenance fee and surcharge upon petition under 37 CFR 1.378, the patent shall be considered as not having expired but would be subject to the intervening rights and conditions set forth in 35 U.S.C. 41(c)(2).

For instructions on filing a petition under 37 CFR 1.378 to reinstate an expired patent, customers should call the Office of Petitions Help Desk at 571-272-3282 or refer to the USPTO Web site at www.uspto.gov/web/offices/pac/dapp/petitionspractice.html. The USPTO also permits reinstatement under 37 CFR 1.378(c) by electronic petition (e-petition) using EFS-Web; e-petitions may be automatically granted if all the eligibility requirements are met. For further information on filing an e-petition, please call the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 571-272-4100 or refer to the EBC's e-petition guide at www.uspto.gov/efc/portal/efs/petition_quickstart.pdf.

PATENT NUMBER	U.S. APPLICATION NUMBER	PATENT ISSUE DATE	APPLICATION FILING DATE	EXPIRATION DATE	ATTORNEY DOCKET NUMBER
5542662	08355707	08/06/96	12/14/94	08/06/08	69200A756

NOTE: This notice was automatically generated based on the amount of time that elapsed since the date a patent was granted. It is possible that the patent term may have ended or been shortened due to a terminal disclaimer that was filed in the application. Also, for any patent that issued from an application filed on or after June 8, 1995 containing a specific reference to an earlier filed application or applications under 35 U.S.C. 120, 121, or 365(c), the patent term ends 20 years from the date on which the earliest such application was filed, unless the term was adjusted or extended under 35 U.S.C. 154 or 156.

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Darby & Darby Dissolving after 115 Years in Business



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Written by **Gene Quinn**
President & Founder of **IPWatchdog, Inc.**
Patent Attorney, Reg. No. 44,294
Zies, Widerman & Malek
[E-mail](#) | [Blog](#) | [Twitter](#) | [LinkedIn](#)
Posted: March 12, 2010 @ 4:02 pm

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Earlier today Darby & Darby, one of the oldest intellectual property boutique firms in the [▶ Netweel](#) United States, announced that they are dissolving. The announcement, which seems to have come without much warning, confirms rumors that started swirling last night that an abrupt end was near for the firm that has been in business since 1895. Darby & Darby has offices in New York, Seattle, Washington DC, Palm Beach Gardens and Frankfort. Details remain murky, and no one seems to know exactly when the doors will be shuttered, but here is the text of the announcement:

It is with a heavy heart that we announce that after more than 100 years in continuous operation, Darby & Darby will begin the process of winding down the firm in anticipation of an orderly dissolution. While we continue to have exceptional clients, from individual inventors to Fortune Global 500 Companies, and remain profitable, many of the factors frequently cited in demise of other firms' have made a similar impact on us.

So why would Darby & Darby elect for an orderly dissolution when they have clients many firms and attorneys would love to have and they remain profitable? It is unclear, but the reference to the factors cited in the demise of other firms does provide some clues. Increasingly the IP boutique firm is disappearing. The first sign of trouble is the mass exodus of attorneys who leave to go to another large firm that has or wants to develop an intellectual property department.

It seems it is increasingly difficult for large IP boutiques to compete in a world where full service mega-firms

continue to grow and are capable of providing one-stop-shop services to meet all the needs of a client. This seems to be true of Darby & Darby as well, and if what they say can be taken at face-value, it seems that the decision to dissolve was made prior to the acceleration of a downward spiral. Perhaps Darby & Darby just wanted to go out on their own terms, rather than as a result of mounting financial pressure.

According to the homepage of Darby & Darby, the firm describes itself as follows:

Darby & Darby, P.C. is a full-service intellectual property law firm. As one of the oldest intellectual property firms in the world, we have long been an important player in pioneering and precedent-setting IP matters. Our attorneys hold advanced technical degrees and have distinguished academic credentials. We are intellectual property strategists, counseling our clients on how to maximize the value of their patents, trademarks, copyrights, and trade secrets.

There is no doubt that Darby & Darby has been a major player in the intellectual property world for a very long time, and while it is never easy to see the dissolution of such a venerable name, and even harder to watch our friends and colleagues go through the associated stress of such a closing, in time the industry will absorb the attorneys and support staff and the industry will proceed onward. At a time with such economic upheaval, such a loss could find many looking for work longer than usual though.



Over the last 6 to 12 months there have been a variety of anecdotal reports that business is down everywhere all across the board. The industry-wide data in terms of patent filings at the United States Patent and Trademark Office do not bear out the level of industry decline that many speak of. I have no doubt that those who report such a decline are accurately reporting what they are seeing, but the numbers across the industry, at least on the patent side, do not tell the same story. In fact, fiscal year 2008 saw a record number of patent applications filed at the USPTO, and while down for fiscal year 2009, FY 2009 saw more patent applications filed than any other year except for FY 2008. Reports emanating from the campus of the USPTO suggest that so far FY 2010 is ahead of the predicted pace, and if Congress would allow the USPTO to keep all of its revenues in FY 2010 the \$200 million hole may fill itself simply due to increased filings over projections. So something is not adding up.

It seems that there is a major reconfiguration within the patent law community. I know large firms that have patent departments that have an extraordinarily large amount of business that continues to grow despite what many might call exorbitant hourly rates. I also know many small firms that are also seeing a large increase in business, and some of the patent searchers I talk to tell me they see the same. So why then

are some reporting extraordinary decreases in business?

In the past I have opined that the days of the mahogany table, marble floor law firms is gone. I think that is too simplistic though. It seems that there is a growing tale of three sectors of the industry. There are those that cater to independent inventors primarily and offer extremely low price points. There are those that cater to entrepreneurs and small businesses primarily and offer a price point much higher than independent inventor prices, but substantially lower than large firm prices. Then there are those who primarily cater to well established corporations with large intellectual property portfolios. It seems that in this higher end segment the large IP boutique firms simply can no longer compete with the large mega-firms that can handle anything a Fortune 1000 clients walks in with as an issue. So it seems to me that where the squeeze is coming, and where the stories of dramatic decline are most prevalent, are in the once dominant large IP boutique firms, such as Darby & Darby.

Even this analysis, however, likely over-simplifies matters. One thing I have come to realize through my career is the legal IP industry is rarely constant. Yes, the longevity of the large IP boutiques masked the dynamic nature of the legal IP industry for a very long time, but attorneys are always on the move it seems. For some time there has been a revolving door at IP firms, particularly patent firms. Large firms work many associates like slaves and eventually they move on to greener pastures, whether that be in house or out on their own where they can make more money and work half the hours. Head hunters are always looking for candidates to serve up to large firms, at least before this last recession anyway. The calls from head hunters are a part of the industry and if you are looking out for yourself and your family you might just take a better offer, which is certainly anything but unheard of. So there has always been turmoil within the industry, but never before has it been so obvious in light of the number of old and well regarded IP boutiques that have gone under over the last decade.

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About the Author

Gene Quinn is a US Patent Attorney, law professor and the founder of IPWatchdog.com. He is also a principal lecturer in the top patent bar review course in the nation, which helps aspiring patent attorneys and patent agents prepare themselves to pass the patent bar exam. Gene's particular specialty

as a patent attorney is in the area of strategic patent consulting, patent application drafting and patent prosecution. As an electrical engineer by training his practice primarily focuses on software, computers and Internet innovations, as well as electrical and mechanical devices. Gene has been quoted in the Wall Street Journal, the New York Times, the LA Times, CNN Money and various other newspapers and magazines worldwide.

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6 comments

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1. patent leather [March 13th, 2010 2:14 am](#)

Those who previously predicted the demise of the small to mid sized IP boutiques were flat wrong. With companies cutting their legal budgets, the huge overhead at the big firms (both IP and general) means partners with billing rates of \$400+. Darby & Darby is (was?) a great firm, but can they really write a better patent application than a competent lawyer at a smaller firm? My answer is, generally speaking, no. I already see lots of work being sent to smaller firms and I think the trend will continue.

2. old cumudgeon [March 13th, 2010 1:07 pm](#)

It seems bizarre to have now outlived, just in the past few years, several of the most famous patent law firms of our patent law youth, the prestige leaders in IP litigation for so many generations. [Besides Darby & Darby, it has been Pennie & Edmonds; Fish & Neave; Morgan & Finnegan; and Kenyon & Kenyon, as I recall? All in NYC?]

[Of course many [but by no means all] former partners and associates have been absorbed into giant GP law firms [which no longer refer any client IP work out to specialized IP firms unless the clients do it themselves].

I believe that this is further exacerbating a great divide between PTO practice and patent litigation, in which fewer and fewer attorneys doing patent litigation seem to have ever had any working knowledge of what goes on in the PTO in obtaining patents, and don't care as long as they can produce enough litigation billing hours to meet the ravenous billing demands needed to retain their jobs in those giant impersonal businesses of 1000 or more attorneys. This trend of patent litigation by those who have never practiced before the PTO or even the CAFC does always not bode well for clients who need, for example, reexaminations, reissues, Board appeals, CAFC appeals, etc. While, on the other hand, most of those now preparing and prosecuting patent applications these days have not had any direct litigation experience and too often lack appreciation of how their PTO work may affect their patents if they are ever litigated, and are now often [unlike litigators] under severe cost constraints precluding adequate training, supervision or review. Many of the patents now being obtained as cheaply as possible will never be infringed or otherwise be fit for litigation, except from concienious senior members of low overhead small firms.

3. Jerry Stanton [March 16th, 2010 4:13 pm](#)

I'm not sure if I believe Darby was done in by competition from full service firms, which is the premise underlying Gene's conclusion of the beginning of the end of the boutique patent firms catering to corporate patent work. I recall reading of a large and storied general practice firm in San Francisco that closed up shop last year. They'd gotten into the habit of taking a loan to pay bonuses and operating expenses at the beginning of their fiscal year,

which in recent years took them 9+ months to pay off. As the economy tanked a few partners got cold feet and left, too many, which violated the terms of the loan. The bank called it in, even more partners left, the firm couldn't pay and had no choice but to close their doors. Now I have no idea whether Darby was so boneheaded as to pay bonuses out of a loan and my own bias is that a boutique patent firm is likely a bit more conservative cash-wise than the average large GP firm, but apparently partners have been leaving Darby over the past few years. The business of lawyering is relationship based and each partner has a good shot at taking his own clients and a few extras with them when they leave. A few of those defections and any firm would be in dire cash straights trying to manage high-dollar associate payroll while keeping some consistency for remaining clients.

Why those Darby partners left I think is the key to why Darby's closed up. I've seen Darby's NYC rates and they didn't leave because they could bill much higher from the offices of a general practice firm. Maybe the GP firms saw it was easier to expand by pirating talent with their own book of business from Darby than by organically growing it themselves, or maybe the defecting partners saw some writing on the wall early on. Whatever the reason, I think the evidence is not in to conclude that Darby is closing because corporate America/Europe wants one stop legal shopping.

4. OldTimer March 17th, 2010 5:59 pm

Darby is folding for the same reason that all the other Bigtiques have folded. The money in this business is in litigation, not prep/pros. Their litigators have been leaving to go to big GP firms where they can build a bigger empire and make more money. Every time a litigator leaves the high-margin litigation part of the pie shrinks and the low-margin prosecution part of the pie grows. The last time I checked Darby had 40 some lawyers and 20 some patent agents. You can't run a NY law firm with those kinds of numbers.

5. Another Old Timer March 20th, 2010 4:08 pm

I agree fully with what Old Timer writes: "Darby is folding for the same reason that all the other Bigtiques have folded. The money in this business is in litigation, not prep/pros."

I was in contact with Darby & Darby way back in 1984, when it had its offices at the prestigious Chrysler Building in Manhattan. I was then a patent attorney for a European corporation that entered the US markets that year through a joint-venture deal with a big consumer electronics outfit in the US. Darby's professionals helped us admirably in our search for possible patents infringements. I found their services helpful, while at the same time being very friendly and cordial. This old venerable IP boutique combined professionalism with a touch of warm personal service- a rare quality in present day mega-law firms, who are more interested in milking their clients with a \$400+/hr rate, than in offering a warm human touch to the rather boring patents business.

With an ongoing boom and explosion of patents litigation in the US- especially in the mobile phones business – it is a pity that old established names like Darby & Darby are vanishing from the scene. One would expect that this boom in patents litigation would provide more work for patent lawyers with experience in that particular area. Darby really had experience in this area.



Or has the business of patents litigation become so large in volume, that such IP boutiques like Darby & Darby simply cannot compete with those big law PLLs that have 1000+ staff?

Are law firms becoming some kind of "WalMart" department stores, that offer you everything you need in legal services but without that essential human and personal touch? What a pity!

6. screwedbylawyer March 23rd, 2010 10:16 pm

this firm has left many people hanging and did not do a very good job in serving their clients near the end at the very least.

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1
2 **DECLARATION OF BONNIE DRINKWATER**

3 I, Bonnie Drinkwater, do hereby declare and state:

4 1. I am an attorney who has been the principal of Drinkwater Law Offices since
5 July 2002. I have personal knowledge of the facts stated herein and can testify competently to
6 them if called upon to do so.

7 2. Drinkwater Law Offices is a law firm that has been operating since July 2002 in
8 the areas of business formation, trademark and copyright law, employment law and real estate
9 law. Today, Drinkwater Law Offices handles hundreds of trademark prosecution files.

10 3. Tachikara U.S.A., Inc. ("Tachikara") has been a client of the Drinkwater Law
11 Offices since about November 1, 2002, when Drinkwater Law Offices began prosecuting
12 several trademark files for Tachikara.

13 4. In about July 2004, Tachikara entered into a Purchase and Sale Agreement
14 whereby it acquired United States Patent No. 5,542,662 (the "'662 patent"), relating to a sports
15 ball and (balloon bladder) production method, and several trademark assets. Drinkwater Law
16 Offices prepared the Purchase and Sale Agreement.

17 5. Tachikara engaged Drinkwater Law Offices to handle Tachikara's intellectual
18 property and other business matter needs.

19 6. Ms. Cindy Hill was the paralegal at Drinkwater Law Offices who was
20 responsible for maintenance of the docketing systems used to ensure all United States Patent
21 and Trademark Office ("USPTO") files were timely maintained. Ms. Hill began work at
22 Drinkwater Law Offices on August 4, 2002 and had completed training for Microsoft®
23 Outlook® prior to when she was hired. I directly supervised Ms. Hill on her work on the
24 USPTO files. For five (5) years she conducted all docketing for Drinkwater Law Offices.
25
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1 7. Drinkwater Law Offices has used two reliable docketing systems for calendaring
2 and tracking all relevant dates related to intellectual property prosecution and maintenance with
3 the USPTO, including the payment of any fees required to maintain assets in force: Outlook's
4 calendar software as well as a Microsoft® Excel®-based spreadsheet system listing renewal
5 dates for each USPTO file. Drinkwater Law Offices has used the Outlook calendaring system
6 and the Excel spreadsheet system since 2002.

7 8. For calendaring on Outlook, Ms. Hill would type in all filing deadlines for each
8 USPTO file, as well as reminders regarding the filing deadlines at the following time
9 increments before each deadline: two months, 1 month, two weeks, one week, one day and the
10 day of the deadline. Attached hereto is a true and correct copy of the Outlook calendar,
11 including filing deadlines for USPTO files, for July 14, 2008 to October 12, 2008 (the oldest
12 such calendar records currently available) (EXHIBIT A). Similarly, for the spreadsheet
13 system, Ms. Hill would type in all filing deadlines for each USPTO file, as well as reminders
14 regarding the filing deadlines at the same time increments as with Outlook.
15

16 9. In response to receiving a reminder from the Outlook system, Ms. Hill would
17 cross check the action required with the spreadsheet system and then notify me of the action
18 required. I would then take immediate action by contacting the client and informing the client
19 of the action required to maintain the application or registration. With the client's permission, I
20 would then timely file the renewal as required. During 2002-2005, I was responsible for and
21 successfully carried out the timely filing of hundreds of renewals to the USPTO.
22

23 10. In accordance with firm practice, a file was created for the business transactions
24 and individual trademark files for Tachikara. However, neither the assignment of the '662
25 patent to Tachikara nor a due date for payment of the third maintenance fee for the '662 patent
26 appear to have made it into the docketing system.
27
28

1 11. In about February 2005, Drinkwater Law Offices filed with the USPTO an
2 assignment for the '662 patent on behalf of Tachikara. The assignment was recorded and
3 included the address of the Drinkwater Law Offices at that time, which was 6490 S. McCarran
4 Blvd., Suite B-15, Reno, NV 89509. Attached hereto is a true and correct copy of the Notice of
5 Recordation of the Assignment of Patent (EXHIBIT B).

6 12. In September 2005, the Drinkwater Law Offices relocated to its current location,
7 5421 Kietzke Lane, Suite 100, Reno, NV 89511. As part of the move, Drinkwater Law Offices
8 set up procedures designed to ensure that all files it had with the USPTO were updated with the
9 new address information.
10

11 13. In September 2005, I verbally instructed Ms. Hill to file change of address forms
12 with the USPTO to update Drinkwater Law Offices' new address for each file and to use the
13 records saved in the Outlook calendaring and excel spreadsheet system to confirm that each file
14 had been updated. Ms. Hill informed me that she had updated all of the files using the
15 docketing systems. However, the assignment of the '662 patent does not appear to have made
16 it into the docketing system. As a result, it does not appear that Ms. Hill filed a change of
17 address form for the '662 patent. That is the only file Drinkwater Law Offices had with the
18 USPTO that appears to not have been updated with Drinkwater Law Offices' new address.
19

20 14. Drinkwater Law Offices never received a notice of renewal for the '662 patent.
21 I suspect this is because the USPTO had the old Drinkwater Law Offices' address, and by the
22 time the notice was sent, no forwarding service was operating.

23 15. On or about March 8, 2011, Dann Burke of Tachikara contacted Drinkwater
24 Law Offices regarding assigning the '662 patent pursuant to a provision of the 2004 Purchase
25 and Sale Agreement. It was at that time that I searched the USPTO records and discovered that
26 the '662 patent had been abandoned for failure to pay maintenance fees. On March 24, 2011, I
27 notified Dann Burke the '662 patent had been abandoned.
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I declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code.

Dated: June 16, 2011

By Bonnie Drinkwater

Bonnie Drinkwater

EXHIBIT A

**July 14 -
July 20**

July 2008							August 2008						
S	M	T	W	T	F	S	S	M	T	W	T	F	S
		1	2	3	4	5						1	2
6	7	8	9	10	11	12	3	4	5	6	7	8	9
13	14	15	16	17	18	19	10	11	12	13	14	15	16
20	21	22	23	24	25	26	17	18	19	20	21	22	23
27	28	29	30	31			24	25	26	27	28	29	30
							31						

Monday, July 14					Thursday, July 17				
8:00am 8:30am TRADEMARK: Samantha Fleischer: TWO OF YOU SERVICES w/ DESIGN: Nevada Mark Renewal (08/14/08)									
Tuesday, July 15					Friday, July 18				
					8:00am 8:30am TM: Sinaps: 77100200 Statement of Use Due 4/20/9 8:30am 9:00am TRADEMARK: RetirementStreet; Retirementstreet.com (2687858): Federal Mark Renewal 5th (02/18/08) - 6th (02/18/09)				
Wednesday, July 16					Saturday, July 19				
					Sunday, July 20				

July 21 - July 27

July 2008						
S	M	T	W	T	F	S
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August 2008						
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31						

Monday, July 21

Thursday, July 24

Tuesday, July 22

Friday, July 25

Wednesday, July 23

Saturday, July 26

8:00am 8:30am Annual Renewal: Carpediem
 8:00am 8:30am Annual Renewal: Global Studio, Inc.
 8:00am 8:30am Annual Renewal: R/A Profit\$
 8:30am 9:00am Annual Renewal: Mustang Memories, LLC
 9:00am 9:30am TRADEMARK: Internet Auto: INTERNET AUTO RENT
 & SALES: Oregon Mark Renewal (09/03/08)
 9:30am 10:00am Annual Renewal: Arizona PWP
 10:00am 10:30am Annual Renewal: Movement Based Learning, Inc.
 11:00am 11:30am Annual Renewal: Schaller Construction-Arizona

Sunday, July 27

October 27 - November 02

October 2008							November 2008						
S	M	T	W	T	F	S	S	M	T	W	T	F	S
				1	2	3	4						1
5	6	7	8	9	10	11		2	3	4	5	6	7
12	13	14	15	16	17	18		9	10	11	12	13	14
19	20	21	22	23	24	25		16	17	18	19	20	21
26	27	28	29	30	31			23	24	25	26	27	28
								30					

Monday, October 27					Thursday, October 30				
8:00am 8:30am TM: Black Rock Systems, LLC: BLACKROCK EVOLUTION (77/092152): Statement of Use Due (11/27/08)					8:00am 9:00am Slnaps: Statement of Use or 2nd Extension is due today 9:00am 9:30am TM: Slnaps: SINAPS, 77100200, Deadline 10/30/08, Specimens or 3rd Extension				
Tuesday, October 28					Friday, October 31				
					8:30am 9:00am TRADEMARK: Care Network: EMPLOYERS OCCUPATIONAL HEALTH, INC. (2 Classes): State Mark Renewal (12/02/08)				
Wednesday, October 29					Saturday, November 01				
8:00am 8:30am TRADEMARK: EICON: EACCESS LOGO (76264790/2645423): Federal Mark Renewal 6th (11/05/08) 8:30am 9:00am TRADEMARK: EICON: RISH SOURCE LOGO (76264793/2645424): Federal Mark Renewal 6th (11/05/08)									
					Sunday, November 02				

October 20 - October 26

October 2008							November 2008						
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12	13	14	15	16	17	18	19	10	11	12	13	14	15
19	20	21	22	23	24	25	26	16	17	18	19	20	21
26	27	28	29	30	31			22	23	24	25	26	27
								28	29	30			

Monday, October 20		Thursday, October 23	
8:00am 8:30am TRADEMARK: EICON: F EMPLOYERS EMPLOYERS INSURANCE GROUP: Nevada Mark Renewal (04/20/09)		8:00am 8:30am Annual Renewal: Carpediem - Utah 8:00am 8:30am Annual Renewal: Carrara Group 8:00am 8:30am Annual Renewal: N. NV Regional MLS 8:30am 9:00am Annual Renewal: PWP - Bakersfield 8:30am 9:00am Annual Renewal: PWP - Oregon 8:30am 9:00am Annual Renewal: SEMSA - CA 9:00am 9:30am Annual Renewal: Light+Space 9:00am 9:30am Annual Renewal: October Sun 9:00am 9:30am Annual Renewal: Robert J. Riley 9:30am 10:00am Annual Renewal: BSBG, Inc. 9:30am 10:00am Annual Renewal: ManFu Corp. 10:00am 10:30am Annual Renewal: Employer Success, Inc. 10:30am 11:00am Annual Renewal: JLIH, Inc. 10:30am 11:00am Annual Renewal: Two Daughters LLC 11:00am 11:30am Annual Renewal: DA Squared 11:00am 11:30am Annual Renewal: Demolition Tool, Inc. 11:30am 12:00pm Annual Renewal: AGC Manufacturing, LLC More Items...	
Tuesday, October 21		Friday, October 24	
		8:00am 8:30am TRADEMARK: Millis Lane III: Let's Get It On (2220312): Federal Mark Renewal 9th (01/26/08) - 10th (01/26/09)	
Wednesday, October 22		Saturday, October 25	
		Sunday, October 26	

October 13 - October 19

October 2008							November 2008						
S	M	T	W	T	F	S	S	M	T	W	T	F	S
				1	2	3	2	3	4	5	6	7	8
5	6	7	8	9	10	11	9	10	11	12	13	14	15
12	13	14	15	16	17	18	16	17	18	19	20	21	22
19	20	21	22	23	24	25	23	24	25	26	27	28	29
26	27	28	29	30	31		30						

Monday, October 13					Thursday, October 16				
					8:00am 8:30am TM: Sinaps: SINAPS, 77100200, Deadline 10/30/08, Specimens or 3rd Extension				
Tuesday, October 14					Friday, October 17				
					TRADEMARK: Nothing To It: NOTHING TO IT (2218973): Federal Mark Ren				
					8:00am 8:30am TRADEMARK: Dog Gone Quilts: DOG GONE QUILTS (76365594/2697477): Federal Mark Renewal 5th (03/18/08) - 6th (03/18/09)				
					8:30am 9:00am TRADEMARK: EICON: EMPLOYERS INSURANCE GROUP (T2301223334): Montana Mark Renewal (04/19/09)				
					9:00am 9:30am TRADEMARK: EICON: EMPLOYERS INSURANCE GROUP (5639920-0190): Utah Mark Renewal (04/19/09)				
					9:30am 10:00am TRADEMARK: EICON: E EMPLOYERS EMPLOYERS INSURANCE GROUP W/DESIGN: Montana Mark Renewal (04/19/09)				
					10:00am 10:30am TRADEMARK: Neighborhood Mediation Center: GOLDEN CHOICES: Nevada Mark Renewal (11/17/08)				
Wednesday, October 15					Saturday, October 18				
					Sunday, October 19				

October 06 - October 12

October 2008							November 2008						
S	M	T	W	T	F	S	S	M	T	W	T	F	S
			1	2	3	4							1
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12	13	14	15	16	17	18	9	10	11	12	13	14	15
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26	27	28	29	30	31		23	24	25	26	27	28	29
							30						

Monday, October 06					Thursday, October 09				
					8:30am 9:00am TRADEMARK: EICON: E Logo (76264792/2671343): Federal Mark Renewal 5th (01/09/08) - 6th (01/09/09)				
Tuesday, October 07					Friday, October 10				
8:00am 8:30am TRADEMARK: Tachikara: SENSI-TEC (76398397/2770968): Federal Mark Renewal 5th (10/07/08) - 6th (10/07/09)					8:00am 8:30am TRADEMARK: Internet Auto Rent & Sales: INTERNET AUTO RENT & SALES (logo): California Mark Renewal (11/10/08)				
Wednesday, October 08					Saturday, October 11				
8:00am 8:30am TRADEMARK: EICON: EMPLOYERS INSURANCE COMPANY OF NEVADA LOGO (76264791/2630934): Federal Mark Renewal 6th (10/08/08)									
8:30am 9:00am TM: MLS: Statement of Use or Extension for the MLSTIMATE mark: January 8, 2009: Serial No. 77319904									
					Sunday, October 12				

EXHIBIT B

DRINKWATER LAW OFFICES

A PROFESSIONAL CORPORATION
6490 SOUTH MCCARRAN BLVD.
BUILDING B, SUITE 15
RENO NV 89509

February 8, 2005

Dann Burke
Tachikara U.S.A., Inc.
958 United Circle
Sparks, NV 89431

Re: Recordation

Dear Dann:

Enclosed is the United States Patent and Trademark Notice of Recordation for Patent No. 5542662, reflecting the assignment of the patent from Tachikara Co., Ltd. to Tachikara U.S.A., Inc.

If you have any questions regarding the recordation, please feel free to contact me.

Sincerely,

DRINKWATER LAW OFFICES



Bonnie Drinkwater, Esq.

Enclosure

TELEPHONE (775) 828-0800
FAX (775) 828-0858



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

FEBRUARY 01, 2005

PTAS



102805194A

DRINKWATER LAW OFFICES
BONNIE DRINKWATER
6490 S. MCCARRAN BLVD.
SUITE B-15
RENO, NV 89509

UNITED STATES PATENT AND TRADEMARK OFFICE
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320, WASHINGTON, D.C. 20231.

RECORDATION DATE: 08/02/2004

REEL/FRAME: 015629/0245

NUMBER OF PAGES: 2

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

TACHIKARA CO., LTD.

DOC DATE: 07/01/2004

ASSIGNEE:

TACHIKARA U.S.A., INC.
958 UNITED CIRCLE
SPARKS, NEVADA 89431

SERIAL NUMBER: 08355707

FILING DATE: 12/14/1994

PATENT NUMBER: 5542662

ISSUE DATE: 08/06/1996

TITLE: SPORTS BALL AND PRODUCTION METHOD THEREOF

015629/0245 PAGE 2

DIANE RUSSELE, PARALEGAL
ASSIGNMENT DIVISION
OFFICE OF PUBLIC RECORDS

08-04-2004

8.2.04

Form PTO-1595 (Rev. 10/02)		U.S. DEPARTMENT OF COMMERCE U.S. Patent and Trademark Office	
OMB No. 0651-0027 (exp. 6/30/2005)		102805194	
Tab settings			
To the Honorable Commissioner of Patents and Trademarks: Please record the attached original documents or copy thereof.			
1. Name of conveying party(ies): TACHIKARA CO., LTD.		2. Name and address of receiving party(ies) Name: TACHIKARA U.S.A., INC. Internal Address: _____ _____ _____ Street Address: 958 UNITED CIRCLE _____ City: SPARKS State: NV Zip: 89431	
Additional name(s) of conveying party(ies) attached? <input type="checkbox"/> Yes <input checked="" type="checkbox"/> No		Additional name(s) & address(es) attached? <input type="checkbox"/> Yes <input checked="" type="checkbox"/> No	
3. Nature of conveyance: <input checked="" type="checkbox"/> Assignment <input type="checkbox"/> Merger <input type="checkbox"/> Security Agreement <input type="checkbox"/> Change of Name <input type="checkbox"/> Other _____		Execution Date: JULY 1, 2004	
4. Application number(s) or patent number(s): If this document is being filed together with a new application, the execution date of the application is: _____ A. Patent Application No.(s) _____ B. Patent No.(s) 5,542,662		Additional numbers attached? <input type="checkbox"/> Yes <input checked="" type="checkbox"/> No	
5. Name and address of party to whom correspondence concerning document should be mailed: Name: BONNIE DRINKWATER Internal Address: DRINKWATER LAW OFFICES _____ Street Address: 6490 S. McLELLAN Blvd. SUITE B-15 City: RENO State: NV Zip: 89509		6. Total number of applications and patents involved: <input type="checkbox"/> 7. Total fee (37 CFR 3.41) \$ 40.00 <input checked="" type="checkbox"/> Enclosed <input type="checkbox"/> Authorized to be charged to deposit account 8. Deposit account number: _____	
DO NOT USE THIS SPACE			
9. Signature. Mr. Hirobumi Kaihoko, Pres. Name of Person Signing Signature July 01, 2004 Date Total number of pages including cover sheet, attachments, and documents: 2			

Mail documents to be recorded with required cover sheet information to:
Commissioner of Patents & Trademarks, Box Assignments
Washington, D.C. 20231

08/03/2004 MGETACHE 00000069 5542662

01 FC:8021

40.00 DP

Schedule 2.2(a)i

ASSIGNMENT OF PATENT

WHEREAS, Tachikara Co., Ltd., a corporation organized and existing under the laws of Japan ("Assignor"), owns that certain patent for a sports ball and (balloon bladder) production method thereof invented by Keiji Kouzai and Junichi Tanaka and filed in the United States Patent and Trademark Office on December 14, 1994 and which was assigned Patent Number 5,542,662 (the "Patent"); and

WHEREAS, Tachikara U.S.A., Inc., a Nevada corporation ("Assignee"), has entered into that certain Agreement of Purchase and Sale of Intellectual Property and Patent License with Assignor in which Assignor has agreed to sell the Patent to Assignee.

NOW, THEREFORE, for valuable consideration, receipt whereof is hereby acknowledged, Assignor hereby sells, assigns and transfers to Assignee, its successors and assigns, the entire right, title and interest for the United States and elsewhere throughout the world (where such rights may exist onto Assignor), in and to said Patent and inventions related thereto, including any and all divisions and continuations thereof, all rights of priority under the terms of the International Convention for the Protection of Industrial Property, and any and all Letters Patent which may be granted thereon, including any and all renewals, reissues and prolongations thereof, with all the rights, powers, privileges, and advantages in any way arising from or pertaining thereto, for and during the term or terms of any and all such Letters Patent when granted, including any and all renewals, reissues and prolongations thereof, for the use and benefit of said Assignee assigns and legal representatives, in as ample and as beneficial a manner for all intents and purposes as said Assignor might or could have held and enjoyed the same had this assignment not been made.

ASSIGNOR:

Tachikara Co., Ltd.

By: 

Date: July 1, 2004

Name: Hirobumi Kaihoko

Title: President

1
2 **DECLARATION OF DANN BURKE**

3 I, Dann Burke, do hereby declare and state:

4 1. I have been the President and CEO of Tachikara USA, Inc. ("Tachikara") since
5 April 6, 1993. I have personal knowledge of the facts stated herein and can testify competently
6 to them if called upon to do so.

7 2. Tachikara has been operating since April 6, 1993 and imports and distributes
8 inflatable sports balls.

9 3. Tachikara has been a client of Drinkwater Law Offices ("DLO") since about
10 November 1, 2002, when DLO began prosecuting several trademark files for Tachikara.

11 4. In about July 2004, Tachikara entered into a Purchase and Sale Agreement
12 whereby it acquired United States Patent No. 5,542,662 (the "'662 patent"), relating to a sports
13 ball and (balloon bladder) production method, and several U.S. and Canadian trademark assets.
14 DLO prepared the Purchase and Sale Agreement.

15 5. The '662 patent is the only patent that Tachikara has ever owned. I have never
16 owned any patents and, with the exception of my involvement with the Purchase and Sale
17 Agreement, I have had very little experience with patents.

18 6. On September 19, 2007, Tachikara engaged DLO to consolidate the handling of
19 all of Tachikara's intellectual property, including the '662 patent and the trademark assets
20 acquired in the Purchase and Sale Agreement. This is before the third maintenance fee was due
21 by February 6, 2008, or due by August 6, 2008, with surcharge. The engagement letter with
22 DLO states "Intellectual Property Matter" as the area of service provided. I understood patents
23 were included in "Intellectual Property Matters." See the Engagement Letter (EXHIBIT A).
24 See also the letter dated September 19, 2007, instructing the transfer of all of Tachikara's
25 Intellectual Property files from Guild, Russell, Gallagher & Fuller, Ltd. to Drinkwater Law
26
27
28

1 Offices (EXHIBIT B). During my discussions with Bonnie Drinkwater of DLO about
2 consolidating my Intellectual Property Matters with DLO, she told me that DLO had a
3 calendaring system for monitoring IP renewals. I therefore understood that DLO was taking
4 responsibility for tracking in the calendaring system any payments required to maintain in force
5 the '662 patent and the trademark assets acquired in the Purchase and Sale Agreement.

6 7. In about July 2004, I authorized DLO to file with the United States Patent and
7 Trademark Office ("USPTO") a copy of the Purchase and Sale Agreement assigning the '662
8 patent to Tachikara. See Recordation Letter from DLO addressed to me, reporting the
9 successful recordation and including the Notice of Recordation (EXHIBIT C).

10 8. In September 2005, DLO notified me that it was relocating to its current
11 location, 5421 Kietzke Lane, Suite 100, Reno, NV 89511 and all services would continue as
12 expected.

13 9. In October 2006, DLO contacted me regarding the payment due for the second
14 10-year renewal of Tachikara's U.S. Trademark Registration No. 1067737 ("TACHIKARA")
15 in International Classes 025 and 028, which Tachikara acquired in the Purchase and Sale
16 Agreement. In or around October 2006 I authorized payment of the second 10-year renewal and
17 DLO paid the fee. See attached email from Bonnie Drinkwater of DLO reporting the successful
18 renewal of Registration No. 1067737 (EXHIBIT D). Please also see letter dated March 7, 2007,
19 in which DLO states, with respect to the next renewal for Registration No. 1067737, due
20 between June 2016 and June 2017: "We have calendared this renewal..." (EXHIBIT E). So it is
21 clear that, prior to consolidating all of my Intellectual Property Matters with DLO, I was
22 advised that DLO calendared as a way to maintain Intellectual Property for which it is
23 responsible.

24 10. In May 2008, DLO contacted me regarding the payment due for the second 10-
25 year renewal of Tachikara's U.S. Trademark Registration No. 1100821 ("TACHIKARA")
26

1 design) in International Classes 025 and 028, which Tachikara acquired in the Purchase and
2 Sale Agreement. On or around May 13, 2008, I authorized the second 10-year renewal and
3 DLO paid the fee on my behalf. See attached May 13, 2008, e-mail from Bonnie Drinkwater of
4 DLO confirming the renewal and stating: "I've calendared the next renewal..." (EXHIBIT F).

5 11. On March 8, 2011, I sent an email to Bonnie Drinkwater at DLO about
6 assigning the '662 patent, pursuant to a provision of the 2004 Purchase and Sale Agreement
7 (EXHIBIT G). On March 24, 2011 I received a phone call from Bonnie Drinkwater stating the
8 '662 patent had been abandoned for failure to pay the maintenance fee.

9 12. On March 24, 2011, I immediately consulted DLO about reviving the '662
10 patent. DLO recommended the assistance of an outside party. I was referred to Fincham
11 Downs, LLC. On May 4, 2011, I engaged Fincham Downs, LLC to assist me with preparing a
12 petition to accept delayed payment of the third maintenance fee for the '662 patent.
13
14
15
16

17 I declare that all statements made herein of my own knowledge are true and that all
18 statements made on information and belief are believed to be true; and further that these
19 statements are made with the knowledge that willful false statements and the like so made are
20 punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United
21 States Code.

22
23 Dated: June 16, 2011

By 

Dann Burke, Pres. & CEO

TACHIKARA USA, Inc.

EXHIBIT A

DRINKWATER LAW OFFICES

A Professional Corporation
6490 South McCarran Blvd.
Building B, Suite 15
Reno NV 89509

November 5, 2002

Dann Burke
Tachikara U.S.A., Inc.
958 United Circle
Sparks, NV 89431

Re: Engagement Letter: Tachikara U.S.A., Inc. - Intellectual Property Matters

Dear Dann:

This letter serves to inform you that this firm is pleased to act as counsel in the above-referenced matter and to thank you for selecting us. We have performed a conflict check on our system and no conflict of interest was identified.

You have asked this firm to assist Tachikara U.S.A., Inc. with intellectual property matters.

This letter further serves to inform you what you can expect from us and what I hope we can expect from you during the course of this representation. I will provide legal services in connection with Tachikara U.S.A., Inc.'s intellectual property matters. We have agreed to a \$200/hour fee, plus costs.

We reserve the right to increase or decrease our hourly rates at year-end, dependent upon market demands in existence at that time. Should we make changes to our rates, you will be informed in advance. A monthly billing will be sent to you from this firm. The billings will contain a detailed statement of services performed including the identity of the person who performed the work, the time spent and the hourly rate of that person together with expenses incurred. Please do not hesitate to ask any questions that you may have about any item on any bill. We will see that you are provided with answers to your questions and that billing errors, if any, are corrected immediately.

Telephone: (775) 828-0800
Fax: (775) 828-0858
bdrinkwater@drinkwaterlaw.com

Your assistance is essential to our proper representation of you; therefore, I will from time to time send you copies of papers which involve that matter and ask that you review each promptly and give me your comments, if you have any, as quickly as you can.

You retain the right to terminate our representation in this matter at any time by written notice to me. Similarly, we reserve the right to stop representing you in this or any other matter should we determine that we do not wish to continue. Should either of us terminate the representation, we will return your papers to you or as you direct.

At all times please feel free to ask any questions of me about the matters we are handling, about the things we may do in representing you, or about our billings. I find that continued and open communication and understanding between this firm and our clients is essential to effective representation. This letter is written in that spirit.

If this letter accurately reflects your understanding of our representation, would you please sign the enclosed copy of this letter and return it to me so we both may be sure that we have a correct understanding of our professional relationship.

Sincerely,

DRINKWATER LAW OFFICES

Bonnie Drinkwater
Bonnie Drinkwater, Esq.

Client's Agreement to Terms and Conditions of Representation

The foregoing is accepted and correctly states our arrangement.

Dated this 17th day of November, 2002.

By: 

Dann Burke, Pres. of Tochtubana USA, Inc.

Telephone: (775) 828-0800
Fax: (775) 828-0858
bdrinkwater@drinkwaterlaw.com



NV-W7089-0907

Wednesday, September 19, 2007

Mr. John K. Gallagher, Esq.
Guild, Russell, Gallagher & Fuller, Ltd.
100 West Liberty Street
Suite 800
P.O. Box 2838
Reno, Nevada 89505

Dear John:

We thank you for your past services.

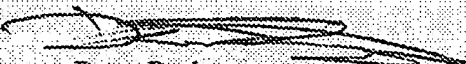
Please transfer all Tachikara files to Drinkwater Law Offices. Their contact information is:

Mrs. Bonnie Drinkwater, Esq.
Drinkwater Law Offices
5421 Kietzke Lane
Suite 100
Reno, Nevada 89511
PH: 828-0800

Please contact Drinkwater Law Offices and they will arrange to pick-up the files. Thank you.

Wishing you many years of success and good health.

Sincerely Yours,
TACHIKARA


Dann Burke
President / CEO

cc: Mrs. Bonnie Drinkwater, Esq. / Mrs. Terry Moberly

TACHIKARA
100 Ireland Drive
McCarran, NV 89434
(775) 352-3500 • FAX (775) 352-3518



TACHIKARA
8000 West 110th Street, Suite 150
Overland Park, KS 66210-2382
(913) 498-1881 • FAX (913) 498-1882

DRINKWATER LAW OFFICES

A PROFESSIONAL CORPORATION
6490 SOUTH McCARRAN BLVD.
BUILDING B, SUITE 15
RENO NV 89509

EXHIBIT C

February 8, 2005

Dann Burke
Tachikara U.S.A., Inc.
958 United Circle
Sparks, NV 89431

Re: Recordation

Dear Dann:

Enclosed is the United States Patent and Trademark Notice of Recordation for Patent No. 5542662, reflecting the assignment of the patent from Tachikara Co., Ltd. to Tachikara U.S.A., Inc.

If you have any questions regarding the recordation, please feel free to contact me.

Sincerely,

DRINKWATER LAW OFFICES



Bonnie Drinkwater, Esq.

Enclosure



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

FEBRUARY 01, 2005

PTAS



102805194A

DRINKWATER LAW OFFICES
BONNIE DRINKWATER
6490 S. MCCARRAN BLVD.
SUITE B-15
RENO, NV 89509

UNITED STATES PATENT AND TRADEMARK OFFICE
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320, WASHINGTON, D.C. 20231.

RECORDATION DATE: 08/02/2004

REEL/FRAME: 015629/0245
NUMBER OF PAGES: 2

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

TACHIKARA CO., LTD.

DOC DATE: 07/01/2004

ASSIGNEE:

TACHIKARA U.S.A., INC.
958 UNITED CIRCLE
SPARKS, NEVADA 89431

SERIAL NUMBER: 08355707

FILING DATE: 12/14/1994

PATENT NUMBER: 5542662

ISSUE DATE: 08/06/1996

TITLE: SPORTS BALL AND PRODUCTION METHOD THEREOF

015629/0245 PAGE 2

DIANE RUSSELE, PARALEGAL
ASSIGNMENT DIVISION
OFFICE OF PUBLIC RECORDS

08-04-2004

8.2.04

Form PTO-1595
(Rev. 10/02)

OMB No. 0651-0027 (exp. 6/30/2005)

Tab settings



102805194

U.S. DEPARTMENT OF COMMERCE
U.S. Patent and Trademark Office

To the Honorable Commissioner of Patents and Trademarks: Please record the attached original documents or copy thereof.

1. Name of conveying party(ies):

TACHIKARA CO., LTD.

Additional name(s) of conveying party(ies) attached? ☐ Yes ☒ No

3. Nature of conveyance:

- ☒ Assignment ☐ Merger
☐ Security Agreement ☐ Change of Name
☐ Other

Execution Date: JULY 1, 2004

2. Name and address of receiving party(ies)

Name: TACHIKARA U.S.A., INC.

Internal Address:

Street Address: 958 UNITED CIRCLE

City: SPARKS State: NV Zip: 89431

Additional name(s) & address(es) attached? ☐ Yes ☒ No

4. Application number(s) or patent number(s):

If this document is being filed together with a new application, the execution date of the application is:

A. Patent Application No.(s)

B. Patent No.(s) 5,542,662

Additional numbers attached? ☐ Yes ☒ No

5. Name and address of party to whom correspondence concerning document should be mailed:

Name: BONNIE DRINKWATER

Internal Address: DRINKWATER LAW
OFFICES

Street Address: 6490 S. McLELLAN Blvd.

SUITE B-15

City: RENO State: NV Zip: 89509

6. Total number of applications and patents involved: 1

7. Total fee (37 CFR 3.41) \$ 40.00

☒ Enclosed☐ Authorized to be charged to deposit account

8. Deposit account number:

DO NOT USE THIS SPACE

9. Signature.

Mr. Hirobumi Kaihoko, Pres.

Name of Person Signing

Signature

July 01, 2004

Date

Total number of pages including cover sheet, attachments, and documents: 2

Mail documents to be recorded with required cover sheet information to:
Commissioner of Patents & Trademarks, Box Assignments
Washington, D.C. 20231

08/03/2004 MBETACHE 00000069 5542662

01 FC:8021

40.00 OP

Schedule 2.2(a)i

ASSIGNMENT OF PATENT

WHEREAS, Tachikara Co., Ltd., a corporation organized and existing under the laws of Japan ("Assignor"), owns that certain patent for a sports ball and (balloon bladder) production method thereof invented by Keiji Kouzai and Junichi Tanaka and filed in the United States Patent and Trademark Office on December 14, 1994 and which was assigned Patent Number 5,542,662 (the "Patent"); and

WHEREAS, Tachikara U.S.A., Inc., a Nevada corporation ("Assignee"), has entered into that certain Agreement of Purchase and Sale of Intellectual Property and Patent License with Assignor in which Assignor has agreed to sell the Patent to Assignee.

NOW, THEREFORE, for valuable consideration, receipt whereof is hereby acknowledged, Assignor hereby sells, assigns and transfers to Assignee, its successors and assigns, the entire right, title and interest for the United States and elsewhere throughout the world (where such rights may exist onto Assignor), in and to said Patent and inventions related thereto, including any and all divisions and continuations thereof, all rights of priority under the terms of the International Convention for the Protection of Industrial Property, and any and all Letters Patent which may be granted thereon, including any and all renewals, reissues and prolongations thereof, with all the rights, powers, privileges, and advantages in any way arising from or pertaining thereto, for and during the term or terms of any and all such Letters Patent when granted, including any and all renewals, reissues and prolongations thereof, for the use and benefit of said Assignee assigns and legal representatives, in as ample and as beneficial a manner for all intents and purposes as said Assignor might or could have held and enjoyed the same had this assignment not been made.

ASSIGNOR:

Tachikara Co., Ltd.

By: 

Date: July 1, 2004

Name: Hirobumi Kaihoko

Title: President

Subj: FW: Received Your Combined Declaration of Use of Mark in Commerce and Application for Renewal of Registration of a Mark under Section 8 & 9 Form for registration number 1067737
Date: 10/26/2006 10:21:52 AM Pacific Standard Time
From: bdrinkwater@drinkwaterlaw.com
To: DannBurke@aol.com
CC: chilli@drinkwaterlaw.com

Dann,

I successfully filed the renewal of the Tachikara trademark. The next renewal will be due between June 14, 2016 and June 14, 2017. Please let me know if you have any questions. Thanks!

Bonnie

From: teas@uspto.gov [mailto:teas@uspto.gov]
Sent: Thursday, October 26, 2006 10:18 AM
To: bdrinkwater@drinkwaterlaw.com
Subject: Received Your Combined Declaration of Use of Mark in Commerce and Application for Renewal of Registration of a Mark under Section 8 & 9 Form for registration number 1067737

We have received your Combined Sections 8 and 9 Declaration/Application for registration number '1067737'. A summary of your submission is listed below. If you determine that you made an error in the information you entered, **DO NOT** request any changes by e-mail, because the TEAS Support Team cannot make corrections. You may submit a new document and new fees, if time remains in the statutory period; however, the USPTO will not refund any fees paid as part of this current submission. For further information, please contact the Post Registration Division at (571) 272-9500, and ask to speak to an Affidavit Renewal Examiner. Or, see Chapter 1600 of the Trademark Manual of Examining Procedure, at <http://tess2.uspto.gov/tmdh/tmep/1600.htm>

REGISTRATION NUMBER: 1067737

REGISTRATION DATE: 06/14/1977

MARK: TACHIKARA

The owner, TACHIKARA U.S.A., INC., having an address of 100 Ireland Dr., McCarran, Nevada US 89434, is filing a Combined Declaration of Use In Commerce & Application For Renewal of Registration of A Mark Under Sections 8 & 9.

For International Class 025, the owner, or its related company, is using the mark in commerce on or in connection with all goods or services listed in the existing registration for this class; or, the owner is claiming excusable non-use for this entire class.

The owner is submitting one specimen showing the mark as used in commerce on or in connection with any item in this class, consisting of a(n) digital photographs of clothing items containing the trademark.

For International Class 028, the owner, or its related company, is using the mark in commerce on or in connection with all goods or services listed in the existing registration for this class; or, the owner is claiming excusable non-use for this entire class.

The owner is submitting one specimen showing the mark as used in commerce on or in connection with any item in this class, consisting of a(n) Digital photo of volleyball and packaging containing the trademark.

The registrant hereby appoints Bonnie Drinkwater to file this Combined Declaration of Use In Commerce & Application For Renewal of Registration of A Mark Under Sections 8 & 9 on behalf of the registrant.

Thursday, October 26, 2006 America Online: Dann Burke

EXHIBIT E

DRINKWATER LAW OFFICES
A PROFESSIONAL CORPORATION

5421 KIETZKE LANE
SUITE 100
RENO, NEVADA 89511

March 7, 2007

Dann Burke
Tachikara U.S.A.
100 Ireland Drive
McCarran, NV 89434

Re: TACHIKARA (Registration No. 1067737)

Dear Dann:

The enclosed Notice of Acceptance/Notice of Acknowledgement was recently received from the United States Patent and Trademark Office. This document is confirmation that the above-referenced registration was maintained as required by the Trademark Act.

The mark will need to be renewed again between June 2016 and June 2017. We have calendared this renewal and we suggest that Tachikara U.S.A. note the renewal as well.

If you have any questions, please contact me.

Sincerely,

DRINKWATER LAW OFFICES



Bonnie Drinkwater, Esq.

Enclosure

TELEPHONE (775) 828-0800
FAX (775) 828-0858

Subj: FW: Received Your Combined Declaration of Use of Mark in Commerce and Application for Renewal of Registration of a Mark under Section 8 & 9 for registration number 1100821
Date: 5/13/2008 2:01:51 P.M. Pacific Daylight Time
From: bdrinkwater@drinkwaterlaw.com
To: DannBurke@aol.com

Dann,

This is the confirmation of the renewal for the Tachikara logo in connection with balls. Please keep it for your records. I've calendared the next renewal in 10 years.

Bonnie

From: teas@uspto.gov [mailto:teas@uspto.gov]
Sent: Tuesday, May 13, 2008 1:58 PM
To: Bonnie Drinkwater
Subject: Received Your Combined Declaration of Use of Mark in Commerce and Application for Renewal of Registration of a Mark under Section 8 & 9 for registration number 1100821

We have received your Combined Sections 8 and 9 Declaration/Application for registration number '1100821'. A summary of your submission is listed below. If you determine that you made an error in the information you entered, **DO NOT** request any changes by e-mail, because the TEAS Support Team cannot make corrections. You may submit a new document and new fees, if time remains in the statutory period; however, the USPTO will not refund any fees paid as part of this current submission. For further information, please contact the Post Registration Division at (571) 272-9500, and ask to speak to an Affidavit Renewal Examiner. Or, see Chapter 1600 of the Trademark Manual of Examining Procedure, at <http://tess2.uspto.gov/tmdb/tnep/1600.htm>

REGISTRATION NUMBER: 1100821

REGISTRATION DATE: 08/29/1978

MARK: TACHIKARA (stylized and/or with design)

The owner, TACHIKARA U.S.A., INC., having an address of 100 Ireland Drive, McCarran, Nevada, United States 89434, is filing a Combined Declaration of Use In Commerce & Application For Renewal of Registration of A Mark Under Sections 8 & 9.

For International Class 025, the owner, or its related company, is NOT using the mark in commerce on or in connection with any of the goods or services listed in the existing registration for this specific class, and is NOT claiming excusable non-use for any of the goods or services listed in the existing registration for this specific class. This entire class is to be **deleted** from the registration.

For International Class 028, the owner, or its related company, is using the mark in commerce on or in connection with all goods or services listed in the existing registration for this class; or, the owner is claiming excusable non-use for this entire class.

The owner is submitting one specimen showing the mark as used in commerce on or in connection with any item in this class, consisting of a(n) a digital photograph of a volleyball and its packaging that both contain the trademark.

Subj: Assignment of Patent
Date: 3/8/2011 11:55:48 A.M. Pacific Daylight Time
From: DannBurke@aol.com
To: bdrinkwater@drinkwaterlaw.com

Dear Bonnie,

Please give me a call so we can celebrate on the phone. :)

Hard to believe it has been almost 7 years since we executed the "Agreement of Purchase and Sale of Intellectual Property and Patent License" agreement dated July 1, 2004.

Since we started the Agreement together, I thought you might enjoy helping me take some of the last few steps. This is a wonderful moment that I struggled and worried about reaching for many years...

On April 15, 2011, we will make our final payment for a total debt payoff of \$4,096,685.97.

Please refer to section 7.3.3 of the July 1, 2004 Agreement (see attached). Once paid in full, we are to gladly transfer a patent right to Yuan Chi Overseas Ltd. & Oriental Spirit Ltd., a Taiwan Corporation.

Please prepare the following for my signature:

- 1) Assignment of Patent No. 5,542,662 dated April 15, 2011.
- 2) Filing of recordation of Assignment with the USPTO, Dated April 15, 2011.

Please date all paperwork for April 15, 2011 and send to me (Assignor) for signature.

On April 15, 2011, let's discuss to be sure final payment is completed by me. Then, please submit Assignment with the USPTO.

I'll then forward copies to Yuan Chi.

Here is the necessary information:

- 1) Patent No. 5,542,662.
- 2) Assignee: Yuan Chi Yuan Chi Overseas Ltd. & Oriental Spirit Ltd., a Taiwan Corporation.
- 3) Assignee Address:

Yuan Chi Overseas Ltd. & Oriental Spirit Ltd.
9F, No. 47, Lane 3, Jihu Road
Neihu Chiu
Taipei, Taiwan 114 R.O.C.

Also attached, please find a copy of the original assignment paperwork filed in 2004.

Thank you for your help.

Take care,
Dann